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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,363	09/25/2001	Takenori Idehara	011350-287	5946
<div>7590 12/23/2008</div> <div>Platon N. Mandros</div> <div>BURNS, DOANE, SWECKER & MATHIS, L.L.P.</div> <div>P.O. Box 1404</div> <div>Alexandria, VA 22313-1404</div>				
<div>EXAMINER</div> <div>REFAI, RAMSEY</div>				
<div>ART UNIT</div> <div>PAPER NUMBER</div> <div>3627</div>				
<div>MAIL DATE</div> <div>DELIVERY MODE</div> <div>12/23/2008</div> <div>PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/961,363

Applicant(s)

IDEHARA ET AL.

Examiner

Ramsey Refai

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-71 is/are pending in the application.
- 4a) Of the above claim(s) 66-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No./Mail Date: _____

DETAILED ACTION

Response to Amendment

Responsive to 'Response to Election/Restriction' filed October 7, 2008. Applicant's election with traverse of Group 1 (claims 46-64) is acknowledged. The traversal is on the ground(s) that there is no serious burden since the examiner has already examined both groups. This is not found persuasive because subcombination II has separate utility such as a controller for deleting the device information if a certain condition is satisfied, which is not required by subcombination I. The two groups require different filed of search as evidenced by the different rejections given in the prior action. Also, the amendment filed June 17, 2008 has presented new evidence and arguments that additionally distinguish the two groups. The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

Affidavit/Declaration

Regarding the 1.131 declaration filed November 9, 2007, attempting to disqualify Lazaridis et al as prior art, the Examiner asserts that the 1.131 is insufficient for at least the following reasons:

The Applicant's evidence does not commensurate with the claimed invention.

The Applicant has used a chart to show how embodiment 7 of the evidence correlates with the language of the claims. However, there appears to be some discrepancies. The chart explains that copying machine A and mobile telephone D together correspond to the claimed data transmission device. This interpretation appears unsupported by pages 79-88 of the evidence. Fig. 25 shows mobile telephone D and copying machine A **as separate devices that**

communicate via local communication and *not as one device* as argued. Page 79 shows that the mobile telephone D is *carried* by the sender and does not teach that it is part of copying machine A or any other device. How can the telephone that is carried by the sender be part of the claimed data transmission device? It is noted that the specification of the instant application teaches that the data transmission device is a color copying machine (see page 39) and does not teach that any other device or terminal is attached to it. For at least these reasons, the affidavit remains insufficient to disqualify Lazaridis et al as prior art. The Examiner is not questioning the validity of exhibits, but requires that all exhibits be explained clearly and in detail, to the satisfaction of the Examiner, and also how these exhibits commensurate with the claimed invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 46-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Lazaridis et al (U.S. Patent No. 7,000,001).

4. As per claim 46, Lazaridis et al teach a data transmission device (**Fig 5, element 74; message server**) to be used in a system including said data transmission device and a data receiving device (**Fig 5, element 72; printer**) which are connected to a data network (**Fig 5, element 18; Internet**), and at least one portable terminal (**Fig. 5, element 14**) said data transmission device comprising:

a first transmission unit transmitting to said portable terminal without recourse to said data network a signal for obtaining device information from said data receiving device, the data receiving device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**column 6, lines 33-51; server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server**);

a receiving unit for receiving the data receiving device information from said portable terminal without recourse to said data network (**Fig 5; printer address information is received wirelessly from portable device through wireless network**); and

a second transmission unit for transmitting to said data receiving device a signal for requesting a connection based on the device information using said data network (**Fig. 5, step 5, column 6, lines 61-63; server transmits attachment through internet to printer specified by the user using received printer address information**).

5. As per claim 47, Lazaridis et al teach the second transmission unit transmits data to said data receiving device via said data network after establishing a connection with said data receiving device (**column 6, lines 60-61; attachment transmitted after connection with printer is established**).

6. As per claim 48, Lazaridis et al teach said first transmission unit and said receiving unit transmit and receive data with said portable terminal via mobile telecommunication network (**Fig 5, element 16; wireless network**).

7. As per claim 49, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network (**column 5, line 15, column 2, lines 37-41; IP address/URL**)

8. As per claim 50, Lazaridis et al teach said identification code is an IP address (**column 5, line 15, column 2, lines 37-41; IP address/URL**).

9. As per claim 51, Lazaridis et al teach a data receiving device to be used in a system including a data transmission device and said data receiving device which are connected to a data network, and at least one portable terminal said data receiving device comprising:

a transmission unit for transmitting data receiving device information to said portable terminal without recourse to said data network according to a request signal received from said portable terminal without recourse to said data network, the data receiving device information containing connection information for establishing a connection between said data transmission device and said data receiving device (**column 6, lines 33-51; server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server**); and

a connection unit for establishing a connection with said data transmission device according to a signal for requesting the connection transmitted from said data transmission device based on the device information (**Fig. 5, step 5, column 6, lines 61-63; server transmits attachment through internet to printer specified by the user using received printer address information**).

10. As per claim 52, Lazaridis et al teach said transmission unit comprises a communication unit communicating in short distances for transmitting the device information to said portable terminal **(column 3, lines 16-32; IrDA)**
11. As per claim 53, Lazaridis et al teach said communication means for communicating in short distances is a wireless communication means **(Fig 5, element 16, column 3, lines 16-32; IrDA)**.
12. As per claim 54 A data receiving device as claimed in claim 53, in which said communication means for communicating in short distances is based on either Bluetooth, IEEE 802.11, HomeRF, or IrDA**(column 3, lines 16-32; IrDA)**.
13. As per claim 55, Lazaridis et al teach which said communication unit comprises a wired communication unit **(Fig 5; internet)**.
14. As per claim 56, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network **(column 5, line 15, column 2, lines 37-41; IP address/URL)**
15. As per claim 57, Lazaridis et al teach said identification code is an IP address **(column 5, line 15, column 2, lines 37-41)**
16. As per claim 58, Lazaridis et al teach a portable terminal to be used in a system including a data transmission device and a data receiving device which are connected to a data network, and said portable terminal said portable terminal comprising:

a first transmission unit for transmitting to said data receiving device a signal for requesting transmission of device information according to a request from said data transmission device, the device information containing connection information for establishing a connection between said data transmission device and said data receiving device **(column 6,**

lines 33-51; server gives the user the option to print the attachment at a network-enabled printer. user then transmits printer address information to server);

a receiving unit for receiving the device information from said data receiving device **(Fig 5; printer address information is received wirelessly from portable device through wireless network);** and

a second transmission unit for transmitting the device information received from said data receiving device to said data transmission device **(Fig. 5, step 5, column 6, lines 61-63; server transmits attachment through internet to printer specified by the user using received printer address information).**

17. As per claim 59, Lazaridis et al teach said first transmission unit and said receiving unit comprise a communication unit communicating in short distances for transmitting and receiving data with said data receiving device **(column 3, lines 16-32; IrDA).**

18. As per claim 60, Lazaridis et al teach portable terminal said communication means for communicating in short distances is a wireless communication means **(column 3, lines 16-32; IrDA).**

19. As per claim 61. A portable terminal as claimed in claim 60, in which said communication means for communicating in short distances is based on either Bluetooth, IEEE 802.11, HomeRF or IrDA **(column 3, lines 16-32; IrDA).**

20. As per claim 62, Lazaridis et al teach said communication unit comprises a wired communication unit **(Fig 5, element 18; internet).**

21. As per claim 63, Lazaridis et al teach said second transmission means transmits the device information to said data transmission device via a mobile telecommunication network **(Fig 5, element 16; wireless network).**

22. As per claim 64, Lazaridis et al teach said connection information contains an identification code for identifying said data receiving device on said data network (**column 5, line 15, column 2, lines 37-41; IP address/URL**).

23. As per claim 65, Lazaridis et al teach said identification code is an IP address (**column 5, line 15, column 2, lines 37-41**).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
December 22, 2008
/R. R./
Examiner, Art Unit 3627

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627